

REMARKS/ARGUMENTS

This Response After Appeal is presented in accordance with Applicants' Notice of Appeal filed August 24, 2011. The appeal was filed with respect to the final Office Action dated February 24, 2011. This Response is filed under 37 C.F.R. § 1.114(d) in lieu of an appeal brief. Accompanying this Response is a Request for Continued Examination. The requisite fees have been paid. The reopening of prosecution, and further examination and reconsideration of the application as amended, are requested.

Claims Pending

Claims 1-4, 6-30, and 32-36 were rejected in the final Office Action of February 24, 2011. Claims 5 and 31 were previously canceled. No claim amendments are presented.

Rejection Under 35 U.S.C. § 103

In the final Office Action, all of the pending claims 1-4, 6-30, and 32-36 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent Publication No. 2005/0033641 to Jha and U.S. Patent No. 7,181,438 to Szabo.

Jha is not a proper reference

Review of the application file indicates that Jha is not a proper prior art reference under 35 U.S.C. § 102. Thus, Jha is not available as a reference under Section 103. Withdrawal of Jha as a reference is requested.

The records of the USPTO indicate that Jha is a published patent application, having been filed on August 5, 2004 and claiming priority to U.S. Provisional Application 60/493022 filed on August 5, 2003. Thus, the earliest possible priority date for Jha under Section 102 is **August 5, 2003**.

The pending patent application was filed on October 27, 2003. Priority of the Provisional Application 60/421507 filed October 25, 2002 was requested in the Petition Under 37 C.F.R. § 1.78 filed February 6, 2008. The petition was granted on July 2, 2008. A corrected Filing Receipt was issued July 2, 2008 showing the claimed priority to the **October 25, 2002** filing. The corrected priority date was acknowledged in the Office Action dated July 8, 2008

(see Page 2 of the July 8, 2008 Office Action). Therefore, the priority date of the present application is **October 25, 2002**.

The current patent application has a priority date (October 25, 2002) that is earlier than Jha's earliest priority date (August 5, 2003). Withdrawal of Jha as a prior art reference against the pending application is requested.

No Prima Facie Case with Remaining References

It is submitted that the rejection of claims 1-4, 6-30, and 32-36 over the combination of references to Jha and Szabo cannot be supported, given the withdrawal of Jha as a reference. It is submitted that no combination of the remaining references of record can provide the features of the claims.

Szabo, for example, is a database access system that discusses providing a ranking of search results to assist users in locating a document of interest. See, e.g., Szabo at Abstract and at col. 28, lines 1-9 and 50-65. Szabo is not directed to the claimed invention features such as recited in claim 1, which refers to determining ad content to be delivered with a requested document. Szabo also fails to discuss calculating productivity values associated with respective ad sources based on relevance scores of keywords in the requested document.

The remaining references of record cannot supply the features that are missing from Szabo. For example, U.S. Patent No. 6,516,337 to Tripp relates to a search engine that can index data on a network. See, e.g., Tripp at col. 5, lines 9-21. U.S. Patent Application Publication No. 2002/0169760 to Cheung discusses managing a list of search engine results and assigning an economic value to network locations corresponding to the list. See, e.g., Cheung at paragraphs [0025] and [0026].

No combination of the remaining references of record can provide the claimed features that, taking claim 1 as an example, include determining a relevance score for keywords in a preexisting document, calculating productivity values based on payment specified by ad sources for one or more of the keywords, comparing the productivity values, and selecting the ad source with the greatest productivity value. The other independent claims recite similar features and likewise contain features that cannot be provided by any combination of the references.

It is noted that the specification text that supports the pending claims is common to both the pending application and the provisional application to which priority is claimed.

Thus, the pending independent claims are supported from the date of the earliest priority and are not rendered obvious by the references. All of the dependent claims likewise are not rendered obvious by the references. It is submitted that all the pending claims are in condition for allowance.

Withdrawal of the Section 103 rejection of claims 1-4, 6-30, and 32-36 is requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Further, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this paper to Deposit Account No. 20-1430.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



David A. Hall
Reg. No. 32,233

KILPATRICK TOWNSEND & STOCKTON LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 858-350-6100
Fax: 415-576-0300
Attachments
DAH:dah
63881267 v1